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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,732	09/29/2003	Takeshi Kinsho	0171-1022P	6775

2292 7590 01/24/2006

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EXAMINER

LEE, SIN J

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/671,732

Applicant(s)

KINSHO ET AL.

Examiner

Sin J. Lee

Art Unit

1752

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12, 13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-10, 13 and 15-18 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicants canceled claims 11 and 14.
2. In view of the amendment of November 7, 2005, previous 102(b) rejection on claims 2, 4, 16 and 17 over Sakurai et al (JP'693) is hereby withdrawn.

Claim Objections

3. Claim 12 is objected to because of the following informalities: On the fourteenth line following the chemical formulas (L1)-(L3), applicants need to change "with proviso that R^{L04}, R^{L05} and R^{L06} are not methyl groups a the same time" to --- with proviso that R^{L01}, R^{L02} and R^{L03} are not methyl groups at the same time ---. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Sakurai et al (JP 56-110693 and its English translation provided by PTO).

Sakurai discloses (2-carboxyallyl)trimethylsilane ((CH₃)₃SiCH₂-C(=CH₂)-COOH) and (2-butoxycarbonylallyl)trimethylsilane ((CH₃)₃SiCH₂-C(=CH₂)-COO-CH₂CH₂CH₂CH₃) in pg.2, eighth paragraph of English translation. Therefore, Sakurai teaches present compound of formula (1) (present R¹ being a hydrogen atom or a n-butyl group).

Allowable Subject Matter

6. Claims 2-10, 13, and 15-18 are allowed. Sakura et al (JP'693) does not teach or suggest present compound of formula (2), (3), or (4) of claims 2-4. Sakurai et al does

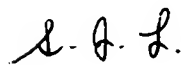
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not teach or suggest present synthesis method of claim 5. Also, as previously indicated, Haider ("A Simple Synthesis of (2-Ethoxycarbonylallyl)trimethylsilane, A Potential Synthone for the Synthesis of 2-Methylene-4-alkanolides", Synthesis (1985), (3), pg.271-2) does not teach or suggest present synthesis method of claim 5, which requires the use of an oxalate (Haider uses ethoxalyl chloride instead). Sakurai et al does not teach or suggest present polymer of claim 6.

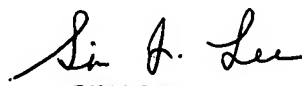
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333. The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Lee
January 21, 2006


SIN LEE
PRIMARY EXAMINER